

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**





# INVENTION-CON 2017

The Place for **Inventors**, **Makers**, & **Entrepreneurs**

**USPTO's Inventors Conference** • August 11-12 • Alexandria, VA

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# Filing for a Patent

## Using EFS Web

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# Overview

- **You will become more familiar with:**
  - Methods of filing an application
  - Different types of applications that can be filed
  - Resources available to aid in the filing process



# Methods of Filing

- **EFS-Web - the USPTO's electronic filing system**
  - Filing your nonprovisional utility application via EFS-Web is the only way to avoid paying an additional "non-electronic filing fee"
- **USPS "Priority Mail Express" to the "Patent Correspondence" address at 37 CFR 1.1.**
  - USPS first class mail can be used for correspondence being filed in an existing application
- **Hand delivery to the Customer Service Window in the Randolph Building of the USPTO Headquarters in Alexandria, Virginia**



# Online Filing Guides

- Provisional Application for Patent
- Nonprovisional (Utility) Patent Application Filing Guide
- Guide to Filing a Design Patent Application
- Plant Patent Application
- Filing a new international application under the Patent Cooperation Treaty (PCT)
  - PCT Legal Administration
  - International Protection
- These guides are available at:
- <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applicationsproceedings>



# Different types of applications that can be filed

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# Provisional Patent Application

- A provisional patent application allows you to file without a formal patent claim, oath or declaration, or any information disclosure (prior art) statement.
- Items required:
  - Specification: a written description of the invention, complying with all requirements of 35 USC 112(a)
  - Drawings necessary for the understanding of the invention
  - Filing fee
  - Cover Sheet (PTO/SB/16)
    - [https://www.uspto.gov/web/forms/sb0016\\_fill.pdf](https://www.uspto.gov/web/forms/sb0016_fill.pdf)



# Provisional Patent Application (*cont.*)

- Use the USPTO cover sheet (PTO/SB/16) to identify:
  - the application as a provisional application for patent;
  - the name(s) of all inventors;
  - inventor residence(s);
  - title of the invention;
  - name and registration number of attorney or agent and docket number (if applicable);
  - correspondence address; and
  - any U.S. Government agency that has a property interest in the application.



# Filing Tips – Provisional

- Read the online filing guide before filing: <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/provisional-application-patent>
- Claims are not required in a provisional application, but it is recommended that the disclosure of the invention be as complete as possible
- Can be filed up to 12 months following an inventor's public disclosure of the invention (e.g., publication, public use, offer for sale, or any activity that otherwise made the invention available to the public)
  - Such a pre-filing disclosure, although protected in the United States, may preclude patenting in foreign countries
- Provisional applications for patent cannot claim the benefit of a previously-filed application, either foreign or domestic
- May not be filed for design applications



# Nonprovisional Patent Application

## Filing Requirements for Examination:

- A specification, including a description and a claim or claims
- Drawings, when necessary for an understanding of the invention
- Inventor information including the legal name, residence, and mailing address of each inventor
- Oath or declaration or an application data sheet
- The prescribed filing, search, and examination fees

## For more Information:

<https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/nonprovisional-utility-patent>



# Surcharge under 37 CFR 1.16(f)

- A surcharge (in addition to any other fees due) will be assessed for:
  - Late submission of the basic filing, search or examination fee
  - Late submission of inventor's oath or declaration
  - Filing an application that does not contain at least one claim on filing
  - Submission of an application filed by reference to a previously filed application

# Filing Tips – Nonprovisional

- Read the online filing guide before filing: <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/nonprovisional-utility-patent>
- Use USPTO forms
  - In general, every applicable section of a form should be completed, but not all sections of a form are applicable to every case
  - If you are unsure which forms to use, ASK!
- Carefully proofread all forms and application papers before submitting
- Register for EFS-Web to file follow-on papers electronically and view your application file wrapper in Private PAIR
  - <https://www.uspto.gov/patents-application-process/applying-online/getting-started-new-users>



# Design Patent Application

- A Design Patent Application should include the following elements (as set forth in 37 CFR 1.154):
  - Design application transmittal form
  - Fee transmittal form
  - Application data sheet (see 37 CFR § 1.76).
  - Specification
  - Drawings or photographs
  - The inventor's oath or declaration (see 37 CFR § 1.153(b))
- The filing fee, search fee, and examination fee are also required.

# Design Patent Application Specification

- **The specification of a Design Patent Application should include the following sections, where applicable, in order:**
  - Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied
  - Cross-reference to related applications (unless included in the application data sheet)
  - Statement regarding federally sponsored research or development.
  - Description of the figure or figures of the drawing
  - Feature description
  - A single claim



# Design Patent Application

- **The drawing disclosure is the most important element of the design application**
  - It is essential that the applicant present a set of drawings (or photographs) of the highest quality which conform to the rules and policies pertaining to the drawing disclosure of a design patent application
  - A design patent application may only include a single claim
    - The claim defines the design the applicant wishes to patent, in terms of the article which embodies the design or to which it is applied
    - The claim must be in formal terms to: “The ornamental design for (the article which embodies the design or to which it is applied) as shown.”
- **While no specific format is required for other required information, it is strongly suggested that applicant follow the formats presented in the design filing guide to ensure that the application is complete**

# Filing Tips – Design

- Read the online filing guide before filing:  
<https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide>
- Photographs are permitted if they are the only practicable medium for illustrating the claimed invention
- To meet the requirements of 35 U.S.C. 112, the drawing disclosure must include a sufficient number of views to constitute a complete disclosure of the appearance of the design claimed
  - It is suggested that perspective views be submitted to clearly show the appearance and shape of three-dimensional designs
- Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is used, may be represented in the drawing by broken lines



# EFS-Web Overview

- USPTO's Web-based electronic filing system (EFS-Web) for patent application submissions
- Available anytime, anywhere with minimal software requirements (e.g., standard Web browser, Internet connection)
- Launched on March 18, 2006
- Immediately routes documents to USPTO internal systems and provides instant electronic Acknowledgement Receipt to user



# Electronic Filing Benefits

- Generates Acknowledgement Receipt to show that the USPTO has received the submission
- Reduces manual processing
- Minimizes paper waste
- Automatically feeds information into internal systems
  - Sends notifications to appropriate processing teams (reduce errors in processing, such as lost files)
- Processes faster by avoiding wait times associated with conventional mailing
- Allows for saving submission package to complete, review, or submit at a later time



# Security Features and Digital Certificates

- All transactions are secure and encrypted
- Digital Certificate (or PKI, Public Key Infrastructure, Certificate)

Provides  
additional security

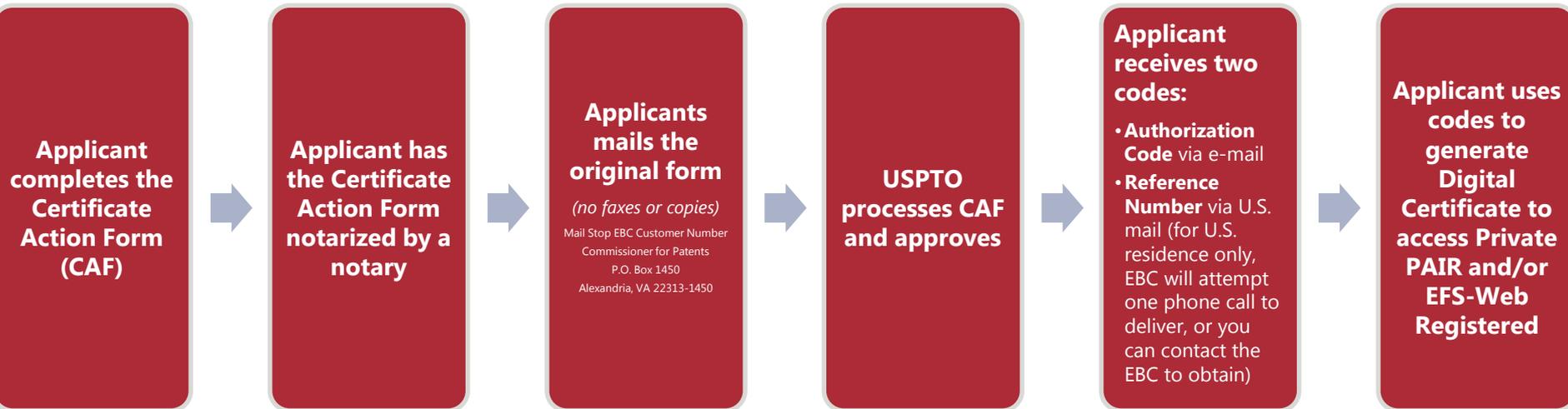
Enhanced 2-step  
authentication

Grants access to  
secured features in  
EFS-Web and  
Private PAIR

uspto

# Digital (PKI) Certificate

Patent attorneys/agents and pro se filers may apply by the following process:



**Digital Certificate Management:** site to manage your digital certificate contact information, create a set of recovery codes and to perform self-recovery of damaged or lost digital certificates online



# Customer Number

- Allows you to easily correlate all your filings and correspondence with a single mailing address, eliminating typographical errors or variations in addresses that can make it difficult to correspond with the USPTO
- To get your unique Customer Number:
  - PAIR Administration option via Private PAIR
  - **OR** Complete Customer Number Request form and fax it to the EBC at 571-273-0177



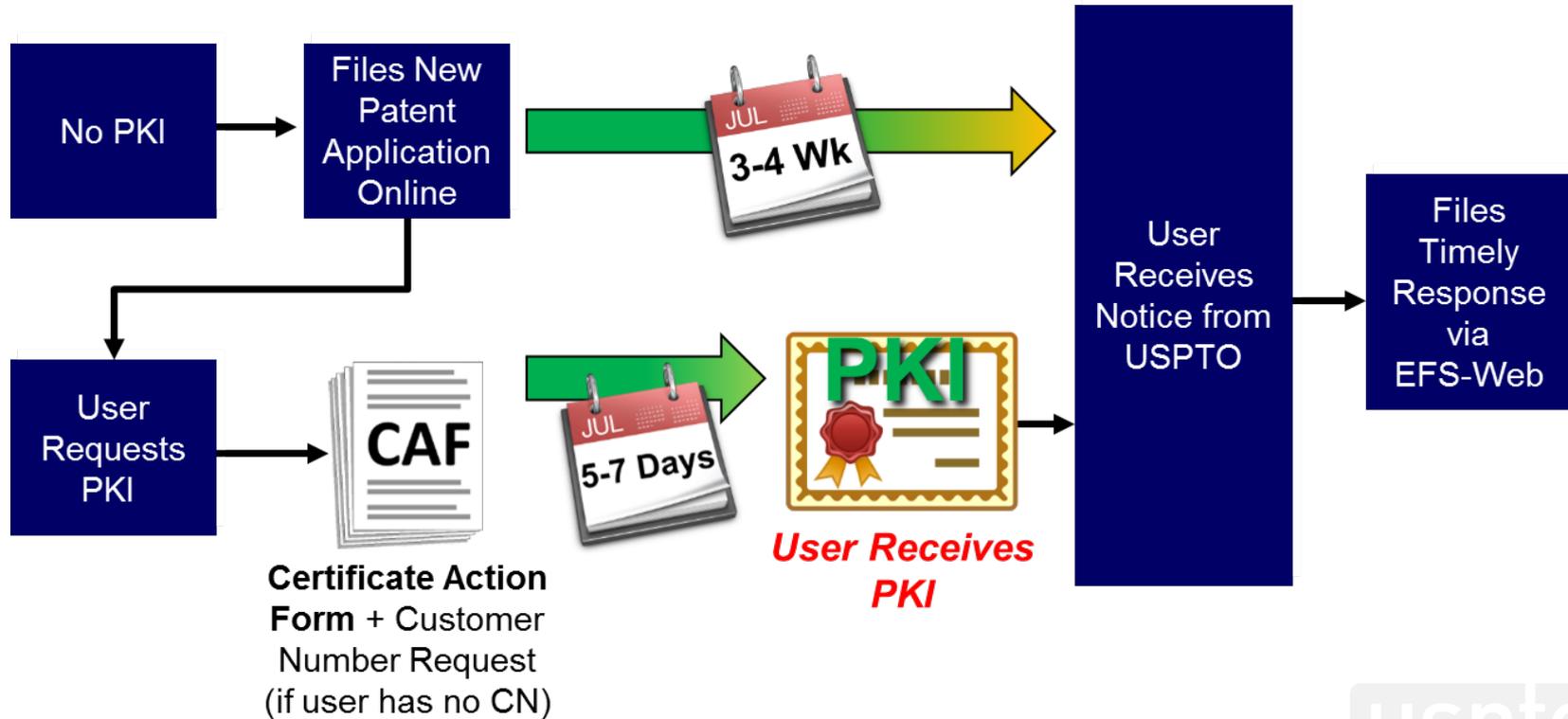
# Customer Number

- To associate existing patent applications to a Customer Number:
  - PAIR Administration (Attorneys or Agents with Registration Numbers only)
  - **OR** Complete Change of Correspondence Address Form SB/122 (single application) and fax to 571-273-8300, or mail to:
    - Commissioner for Patents
    - P.O. Box 1450
    - Alexandria, VA 22313-1450
  - **OR** Complete Customer Number Upload Spreadsheet SB/125 (multiple applications) and mail the CD or USB memory stick to:
    - Mail Stop EBC Customer Number
    - Commissioner for Patents
    - P.O. Box 1450
    - Alexandria, VA 22313-145011



# Digital Certificate Request Process

*(Post Initial Filing)*



# Registered eFiler

- **Has both an assigned Customer Number and Digital Certificate for secure access to application documents both during and after the filing of a patent application**
  - Provides ability to authenticate sessions by requiring positive identification of a customer using Public Key Infrastructure technologies
- **Can save "in-progress" submissions and return to edit them prior to completing filing**
  - Provides added protection against loss of data in the event of a localized internet or office equipment failure or in the event of an unplanned system outage during an online filing session
- **Can electronically process subsequent actions on electronically filed cases without delay**
- **Can review their confidential Private PAIR records for most of their electronically filed cases**



# Registered vs Unregistered EFS-Web

- EFS-Web Unregistered
  - (Without Digital Certificate)

**EFS Unregistered**

Unregistered eFilers Registered eFilers  Please Read Announcements

**Welcome to Electronic Patent Filing for UNREGISTERED eFILERS**  
A submission has not been filed officially at the USPTO until the e-filer executes the submission. All items denoted by \* are required.

**Maintenance Advisory:** Firefox released Firefox 52 on March 7, 2017. This iteration of Firefox may cause issues with EFS-Web. For more information see the [EFS-Web Announcements page](#).

**IMPORTANT:** Please read the [Legal Framework for using EFS-Web](#). For information regarding the new statements under 37 CFR 1.501, please see the [OMB Clearance and PRA Burden Statement](#).

**Sign-on as an UNREGISTERED eFILER**

\* e-Filer Last Name:

\* e-Filer First Name:

\* e-Filer E-Mail Address:

- EFS-Web Registered
  - (With Digital Certificate and Customer Number)

**EFS Registered**

Registered eFilers  Please Read Announcements

**Certification**

A submission has not been filed officially at the USPTO until the e-filer executes the submission. All items denoted by \* are required.

**New Feature (28SEPT2015): Web 85b option now available**  
Effective **September 2015**, due to Chrome discontinuing support for NPAPI, users will no longer be able to log into EFS-Web or Private PAIR. For more information, please see the [New Feature \(28SEPT2015\): Web 85b option now available](#) page.

**IMPORTANT:** Please read the [Legal Framework for using EFS-Web](#). For information regarding the new statements under 37 CFR 1.290, please see the [OMB Clearance and PRA Burden Statement](#), and issue fee transmission.

# Unregistered vs Registered eFiling

## Unregistered eFiler

Basic initial filing of new patent applications, third party submissions, and auto-processed petitions (age & maintenance fee)

Submission must be completed in one session

## Registered eFiler

Enhanced filing, follow-on processing, and other submission types available (such as ePetitions)

Access to secured features, such as Saved Submission Packages and Acknowledgement Receipts

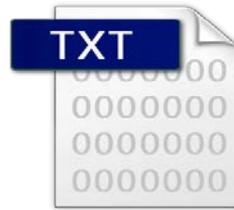
Access to pending application in Private PAIR (Digital certificate and Customer Number)

# Accepted Document Formats



## PDF Files

General Documents



## Text Files

Bio-Sequence Listings,  
Computer Code, Etc.



## DOCX Files

Initial Applications  
(Specification, Claims, Abstract)  
*Limited to eMod Text Pilot  
Program until Summer 2017*



## PCT-SAFE Zip Files

Generated zip files produced by  
the PCT-SAFE software

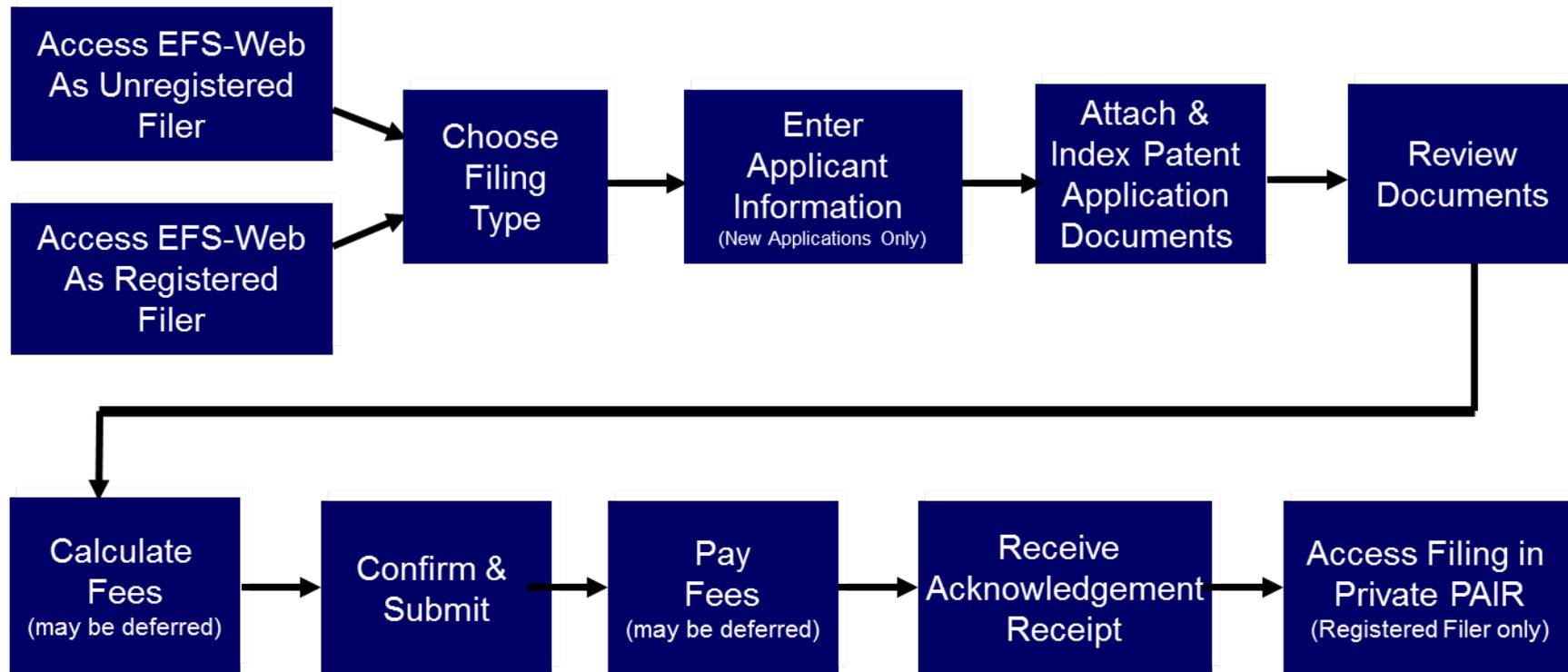


## JPEG Files

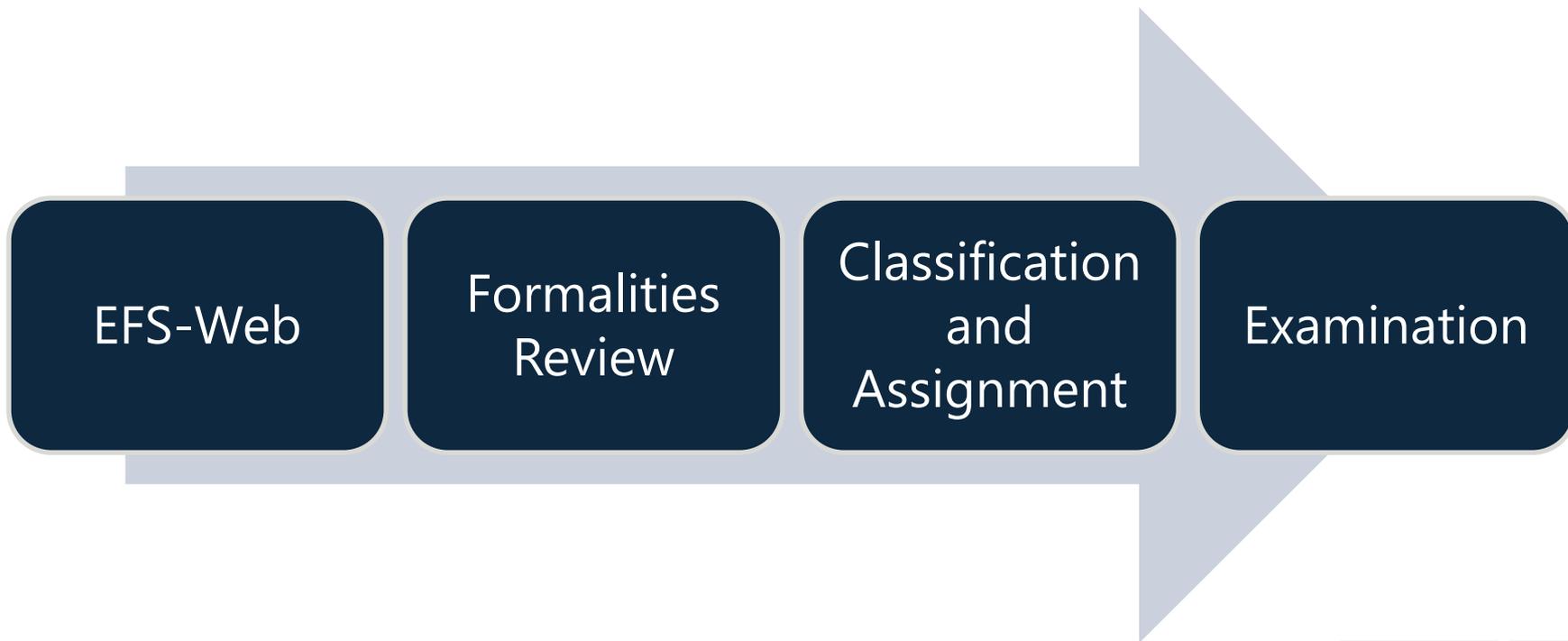
Hague Reproductions  
(Drawings)



# Electronic Filing Process



# Where does it go next?



# PAIR: Patent Application Information Retrieval

- **Public PAIR:** Public applications, published applications and issued patents
- **Private PAIR:** Pending applications, published applications, and issued patents, PAIR Administration
  - A Digital Certificate is required to access unpublished applications
  - To access unpublished applications:
    - Correspondence Address of the application needs to be associated to the Customer Number
    - Customer Number needs to be linked to the Digital Certificate of the PAIR user



# Applicants' Duty to Disclose

## 37 C.F.R. 1.56 – Duty to Disclose Information

- When filing a patent application with the USPTO, you have a “duty of candor and good faith” in dealing with the Office.
- This includes the “duty to disclose” all information you believe to be relevant to the examination of the patent application.

See MPEP § 2001

<https://www.uspto.gov/web/offices/pac/mpep/s2001.html>



# Applicants' Duty to Disclose

## 37 C.F.R. 1.56 – Duty to Disclose Information (*cont.*)

- Who has the duty to disclose?
- “Individuals associated with the filing or prosecution of a patent application”
  - The inventor(s)
  - Attorney(s)/agent(s) who help with the application
  - Every other person who is substantively involved with the application



# Applicants' Duty to Disclose

## 37 C.F.R. 1.56 – Duty to Disclose Information (*cont.*)

- What needs to be submitted?
- Information that is “material” to patentability
- Information is “material” if:
  - It could be used by an examiner to reject a claim of the application; **OR**
  - It refutes a statement you made to the Office.

# Applicants' Duty to Disclose

## 37 C.F.R. 1.56 – Duty to Disclose Information (*cont.*)

- What needs to be submitted?
- Examples
  - Patents and publications material to your invention
  - Any previous selling or publicizing of the invention to the public
  - Inventorship conflicts

# Applicants' Duty to Disclose

## 37 C.F.R. 1.56 – Duty to Disclose Information (*cont.*)

### How do I submit information?

- Information should be submitted via an information disclosure statement (“IDS”)
  - The IDS should be filed as early in prosecution as possible to avoid potential fees. See 37 CFR 1.97 for the full timing requirements.
    - No fee is required for an IDS filed before the examiner’s 1<sup>st</sup> Office action, and in situations where information was later discovered by an individual with a duty to disclose.
  - Use of form PTO/SB/08A and 08B, “Information Disclosure Statement,” is encouraged to meet the content requirements of 37 CFR 1.98.
    - The form is available at: <https://www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012>



# Applicants' Duty to Disclose

## 37 C.F.R. 1.56 – Duty to Disclose Information (*cont.*)

- For more information on IDS practice see MPEP § 609.
  - <https://www.uspto.gov/web/offices/pac/mpep/mpep-0600.pdf>
- Link to tutorial on Filing an IDS:
  - [https://www.uspto.gov/sites/default/files/ebc/portal/efs/dct\\_ids\\_tutorial.pdf](https://www.uspto.gov/sites/default/files/ebc/portal/efs/dct_ids_tutorial.pdf)

# Basic Fees as of April 20, 2017

- Provisional Utility Application

	Large Entity	Small Entity	Micro Entity
Filing Fee:	\$260	\$130	\$65

- Non Provisional Utility Application

	Large Entity	Small Entity	Micro Entity
Basic Filing Fee:	\$280	\$140	\$70
Search Fee:	\$600	\$300	\$150
Examination Fee:	\$720	\$360	\$180
Issue Fee:	\$960	\$480	\$240
Non-electronic Filing Fee:	\$400	\$200	\$200

- Design Application

	Large Entity	Small Entity	Micro Entity
Basic Filing Fee:	\$180	\$90	\$45
Search Fee:	\$120	\$60	\$30
Examination Fee:	\$460	\$230	\$115
Issue Fee:	\$560	\$280	\$140

Fees are subject to change. See the current fee schedule at:

<https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule#Patent Fees>



# Small Entity Status

## An entity that:

- Falls within one of three categories:
  - A nonprofit organization, such as a university,
  - A person, such as an individual inventor
  - A small business concern meeting the standards set forth by the Small Business Administration (SBA), including the requirement that the number of employees, including affiliates, does not exceed 500 persons. See 13 CFR 121.801 through 121.805.
- And has not assigned, licensed or otherwise conveyed an interest in the invention to a non-small entity

# Micro Entity Status (Gross Income Basis)

- To qualify for micro entity status on the gross income basis, the applicant must comply with the:
  - Small entity requirement
  - Application filing limit
  - Gross income limit on applicants and inventors
  - Gross income limit on parties with an ownership interest
- Use form PTO/SB/15A to certify status:  
<http://www.uspto.gov/sites/default/files/forms/sb0015a.pdf>



# Certification of Micro Entity Status (Gross Income Basis)

CERTIFICATION OF MICRO ENTITY STATUS (GROSS INCOME BASIS)			
Application Number or Control Number (if applicable)		Patent Number (if applicable)	
First Named Inventor:		Title of Invention:	
The applicant hereby certifies the following—			
<p>(1) <b>SMALL ENTITY REQUIREMENT</b> – The applicant qualifies as a small entity as defined in 37 CFR 1.27.</p> <p>(2) <b>APPLICATION FILING LIMIT</b> – Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights, or is obligated to assign all ownership rights, as a result of the applicant's previous employment.</p> <p>(3) <b>GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS</b> – Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at <a href="http://www.uspto.gov/patents/law/micro_entity.jsp">http://www.uspto.gov/patents/law/micro_entity.jsp</a> which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.</p> <p>(4) <b>GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST"</b> – Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at <a href="http://www.uspto.gov/patents/law/micro_entity.jsp">http://www.uspto.gov/patents/law/micro_entity.jsp</a> which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.</p>			
SIGNATURE by an <a href="#">authorized party</a> set forth in 37 CFR 1.33(b)			
Signature			
Name			
Date	Telephone	Registration No.	
<input type="checkbox"/>	There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. The required additional certification form(s) signed by the other joint inventor(s) are included with this form.		



# Patent Electronic Business Center (EBC)

## Contact Info

**Hours:** Monday – Friday,  
6:00 AM – 12:00 Midnight (ET),  
except federal holidays

**Telephone Numbers:**

- Toll-Free: 866-217-9197
- Local: 571-272-4100

**Email:** [ebc@uspto.gov](mailto:ebc@uspto.gov)

- Offers in-depth technical support to external users of the USPTO's Patent e-Commerce systems
- Submitting your Patent Application via EFS-Web
- Viewing Application information in Public and Private PAIR
- Searching for Patents in AppFT and PatFT
- Digital Certificate and Customer Number Issues and Assistance
- Java and Web Browser Problems
- Technical Problems or Errors with your Patent Application
- PDX/DAS Registration Inquires and Issues
- Technical Problems with Biotech Tools such as PatentIn and Checker



# Additional Resources

- Pro Se Assistance Program: <https://www.uspto.gov/patents-getting-started/using-legal-services/pro-se-assistance-program>
- Office of Innovation Development (OID):
  - <https://www.uspto.gov/about-us/organizational-offices/office-commissioner-patents/office-deputy-commissioner-patent-administration/office-innovation-development>
  - <https://www.uspto.gov/learning-and-resources/inventors-entrepreneurs-resources>
- Electronic Business Center New User's Page: <https://www.uspto.gov/patents-application-process/applying-online/getting-started-new-users>
- USPTO Patent Databases: <https://www.uspto.gov/patents-application-process/search-patents>
- Common Pitfalls on UPSTO forms: <https://www.uspto.gov/learning-and-resources/newsletter/inventors-eye/common-pitfalls-uspto-forms>
- OID Inventor Info Chat: <https://www.uspto.gov/patents-application-process/inventor-info-chat>



